

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QUAN A. VU and HISATO SHIMA

MAILED

OCT 18 2005

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/249,642

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on August 11, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On April 10, 2001, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the IDS submitted or whether the examiner notified appellants of why the submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

In addition, a review of the file indicates that the appeal brief filed October 28, 2004 and the examiner's mailed January

27, 2005 have used the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on October 28, 2004 and the examiner's answer mailed January 27, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims

may be argued separately or as a group.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed October 28, 2004 and the examiner's answer mailed January 27, 2005:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);
- 2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c)(1)(vi);
- 3) "Argument" as set forth in 37 CFR § 41.37(c)(1)(vii);
- 4) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 5) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

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A substitute appeal brief and a revised examiner's answer that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) consideration of the Information Disclosure Statement filed April 10, 2001; 2) appropriate written notification by the examiner to appellants of such consideration; 3) hold the appeal brief of October 28, 2004 defective; 4) request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37; 5) vacate the examiner's answer and submit a revised examiner's answer in compliance with the new rule effective September 13, 2004 in response to the substitute appeal brief; and 6) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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CRF/tdl